

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-76 are presently pending. Claims amended herein are 11-25, 32, 35-36, 41-42, and 49. Claims withdrawn or cancelled herein are none. New claims added herein are none.

### **Statement of Substance of Interview**

**[0004]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on July 9, 2007. Applicant greatly appreciates the Examiner’s willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, I discussed how the claims differed from the cited art, namely Parts 1 through 3 of the Jumpstart Mechanics references. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0006]** The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the proposed clarifying claim amendments appeared to distinguish over the cited art of record. For example, the Examiner indicated that clarification regarding the deletion of the old operating system distinguished the independent claims over the cited art, namely Jumpstart. However, the Examiner indicated that he would need to review the cited art more carefully and/or do

another search, and requested that the proposed amendments be presented in writing.

**[0007]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

### **Formal Request for an Interview**

**[0008]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0009]** Please contact me or my assistant to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for us, I welcome your call to either of us as well. Our contact information may be found on the last page of this response.

### **Claim Amendments and Additions**

**[0010]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 11-25, 32, 35-36, 41-42, and 49 herein.

## **Formal Matters**

**[0011]** This section addresses any formal matters (e.g., objections) raised by the Examiner.

### **Abstract**

**[0012]** The Examiner objects to the Abstract for containing more than 150 words. Herein, Applicant amends the Abstract, as shown above, to correct the informalities noted by the Examiner.

### **Provisional Double-Patenting Rejections**

**[0013]** Based upon co-pending application 10/662,720, the Examiner rejects claims 25-31 and 32-34 on the grounds of non-statutory obviousness-type double-patenting. Accordingly, Applicant submits herewith a terminal disclaimer to overcome the provisional double-patenting rejection.

## **Substantive Matters**

### **Claim Rejections under § 112**

**[0014]** Claims 1-24, 30-31, 33-34, 36, 39-41, 47-58, 64-68 and 74-76 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**[0015]** Claim 18 and 36 has been rejected as containing the trademark/trade name WinPE™. Claims 18 and 36 have been amended to clarify that WinPE™ is a specific operating system. As such, it is the operating system that is the claim element of which the term WinPE™ is just a modifier to identify a specific example of an operating system.

**[0016]** Claims 1-9, 10, and 50-58 have been rejected as including the element "re-booting the target computer in the pre-installation environment". Applicant proposes amending claims 1, 10, 50, and 58 to clarify that it is the computer that is being rebooted into either the pre-installation environment or into the deployment environment respectively.

**[0017]** Claims 8-9 have been rejected because the Examiner believes that the claims should be implemented under an independent scope and set forth how each independent claim could perform or generate the steps set forth in claim 1. Applicant traverses this rejection as the Examiner is mis-applying *IPXL Holdings, LLC v. Amazon, Inc.* as cited in section 2173.05.

**[0018]** Applicant respectfully submits that claims 8 and 9 are similar to an acceptable product-by-process claim in that they define a computer-readable medium and API which direct a computer to perform the methods set forth in claim 1. Claims 8 and 9 are proper in their construction in that they reference and are dependent from previous claim 1, and still further define the product created having embodied thereon and within the methods of claim 1. Moreover, the metes and bounds of claims 8 and 9 are clearly set forth in the methods of claims 1 from which claims 8 and 9 depend.

**[0019]** The fourth paragraph of 35 U.S.C. § 112 requires a "claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. Claims 8 and 9 satisfy this statutory requirement.

**[0020]** The format of claiming a computer-readable medium with instructions to perform a method, or a computer programmed to perform the method, was approved in *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). The primary difference between the *Beauregard* claims and claims 8 and 9 is that these claims are written in a dependent format. Often this format raises an initial concern because the preambles of the dependent claims differ from the base claims. However, the present dependent claims also comply with a format approved by the Board of Patent Appeals and Interferences in *Ex parte Adrianus P.M.M. Moelands*, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987)

**[0021]** Claim 10 has been rejected as being indefinite as mixing a system claim with a method claim. Applicant respectfully traverses for reasons as outlined with regard to claim 8.

**[0022]** Claims 11-21 have been rejected as being indefinite. Applicant respectfully submits the amendments made to claim 11 to overcome the section 101 rejections also overcome the current rejection.

**[0023]** Claims 22-23 have been rejected in for the same reasons as addressed above with regard to claims 11-21. Further, each claim has been rejected for failing to be implemented in independent scope. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0024]** Claim 24 has been rejected as being indefinite as being a system mixed with a method for use. Applicant respectfully traverses this rejection. Claim 24 has further been rejected as including the claim element "cause the one or more processors to perform a method comprising: using a multi phase...". Please see proposed amendments responsive to the section 101 rejections.

**[0025]** Claims 30-31 have been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0026]** Claims 33-34 have been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0027]** Claims 39-40 have been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0028]** Claim 41 has been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0029]** Claims 47-48 have been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0030]** Claim 49 has been rejected as being indefinite. Applicant respectfully traverses this rejection as outlined with regard to claims 8 and 9.

**[0031]** Accordingly, Applicant asks the Examiner to withdraw this rejection.

### **Claim Rejections under § 101**

**[0032]** Claims 11-24 have been rejected under 35 U.S.C. § 101 because the claimed invention is not directed towards statutory subject matter. Specifically, claim 11 has been rejected because it fails to meet practical, concrete, and tangible results. The applicant proposes amending claim 11 to now claim a method **for remotely imaging multiple target computers with a new operating system** comprising:

**imaging multiple target computers with a new operating system** using a multi-phase image deployment process [~~to remotely image multiple target computers with a new operating system~~], said multi-phase deployment process comprising at least:

a preparation phase in which various data is captured for migration to the new operating system;

a wipe and load phase in which an old operating system is deleted and the new operating system is installed in place; and

a restoration phase in which captured data is migrated to the new operating system

[0033] Independent claim 24 has been amended in a similar manner. The proposed amendments clarifies that the claimed invention has a practical, tangible, concrete result, namely, the remote imaging of multiple computers with a new operating system. As such, Applicant proposes that the section 101 rejections would be overcome in light of the amendments.

[0034] If the Examiner maintains the rejection of these claims, then the Applicant requests additional guidance as to what is necessary to overcome the rejection.

### **Claim Rejections under §§ 102 and/or 103**

[0035] Claims 1-24 and 69-76 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sun Microsystems (Hereafter Sun): "JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of Unbundled Software", (hereinafter "Part 1"); "JumpStart™ Mechanics: Using JumpStart Application for Hands-Free Installation of Unbundled Software", (hereinafter "Part 2"); and Upgrading to the Solaris™ 8 Operating Environment (hereinafter "Part 3").

Applicant respectfully traverses these rejections.



**[0036]** Part 1 through Part 3 does not disclose that the old operating system is deleted from within the pre-installation environment. The Examiner cites Part 1, page 6 as teaching this element. Instead of teaching the deletion of the old operating system, the cited portion simply teaches that certain packages are deleted. Further, these packages are not defined within the cited art. As such, claims 1, and 8-9 are not anticipated by the cited reference.

**[0037]** Claims 11-23, 24 and 69-76 have been rejected as being anticipated. This time the examiner relies upon Part 3, p. 5, first paragraph to teach that the old operating system is deleted and the new operating system is installed in place. Again Applicant respectfully disagrees. The cited portion of Part 3 simply shows (at best) deletion of certain identified clusters. This is not the complete removal of the old operating system. As such, these claims are not anticipated.

**[0038]** The remaining independent claims have either been amended to include a similar element or previously been presented with the aforementioned element. As such, the applicant also believes these claims are allowable for the aforementioned reasons.

### **Dependent Claims**

**[0039]** In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

## **Conclusion**

[0040] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Respectfully Submitted,

Dated: 2007.07.24

By: \_\_\_\_\_

Jason F. Lindh  
Reg. No. 59090  
(509) 324-9256 x215  
jason@leehayes.com  
[www.leehayes.com](http://www.leehayes.com)

My Assistant: Carly Bokarica  
(509) 324-9256 x264  
[carly@leehayes.com](mailto:carly@leehayes.com)